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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/435,257

Applicant(s)

CLEMONS ET AL.

Examiner

Peter Paras, Jr.

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other.

Sequence Compliance

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

APPLICANT IS GIVEN A ONE MONTH EXTENDABLE PERIOD WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 CFR 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Election/Restrictions

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 19, drawn to a fusion protein, classified in class 530, subclass 350.
- II. Claims 34-39, drawn to *in vivo* and *ex vivo* methods for introducing DNA into cells, classified in class 435, subclass 455.
- III. Claims 40-42, and 45, drawn to an *in vitro* method for multimerizing a protein using a ligand, classified in class 530, subclass 402.
- IV. Claims 40-41, and 43-45, drawn to an *in vivo* method for multimerizing a protein using a ligand, classified in class 514, subclass 44.
- V. Claims 46-50, drawn to a kit, classified in class 536, 424 subclass 23.4, 184.1.

Claims 1-18 and 19-33 are generic to groups II-V and will be examined accordingly with respect to the elected group.

Inventions I and II-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The fusion protein of invention I can be used as an antigen in an animal to generate antibodies. The methods for inventions II-IV can be used with transform cells *in vitro* with materially different products. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and separate search requirement, restriction for examination purposes as indicated is proper.

Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The fusion protein of invention I can be used as an antigen to generate antibodies in an animal. The nucleic acid molecules of the kit of invention V can be used as probes in a hybridization assay. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and separate search requirement, restriction for examination purposes as indicated is proper.

Inventions II-IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The methods of inventions II-IV can be used to transform somatic cells in vitro. The nucleic acid molecules of the kit of invention V can be used as probes in a hybridization assay. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and separate search requirement, restriction for examination purposes as indicated is proper.

Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for inventive groups that are directed to different methods,

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restriction is deemed to be proper between groups II, III, and IV because their methods appear to constitute patentably distinct inventions, each with a distinct purpose and further comprising distinct methodologies and using different products. Because these inventions are distinct for the reasons given above and a separate search is required for each of Groups II, III, and IV restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

A telephone call was made to David Bernstein on 7/19/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner(s) should be directed to Peter Paras, Jr., whose telephone number is 703-308-8340. The examiner can normally be reached Monday-Friday from 8:30 to 4:30 (Eastern time).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Stanton, can be reached at 703-308-2801. The FAX phone number for art unit 1632 is 703-308-0294.

Inquiries of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is 703-308-0196.

Peter Paras, Jr.

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L
C. White,
Patent
Examiner
Art 1632